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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,126	03/30/2001	Hassan A. Serhan	DEP0546	8872

7590 01/14/2003
Philip S. Johnson
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EXAMINER

MANAHAN, TODD E

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 01/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/822,126

Applicant(s)
Serhan et al

Examiner
Todd E. Manahan

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3732



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 Oct 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 17-65, and 67-80 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-12, 17-65, and 67-80 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

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Response to Amendment

Upon reconsideration of the previously Restriction Requirement, Paper No. 2, mailed 19 September 2002, it appears that there were errors with the grouping of the claims and identified species contained in the instant application. Therefore, the previous restriction requirement is hereby withdrawn.

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12, 17-30, 36-48, 58-65, 67-80, drawn to the combination of a ligament and a fastener, classified in class 606, subclass 72.
- II. Claims 49-57, drawn to a ligament, classified in class 623, subclass 13.19. (It is noted that in applicant's response filed 24 October 2002, claims 13-16 and 66 were canceled by applicant as being drawn to the non-elected invention of Group II, the ligament. These claims would still be properly grouped as drawn to the invention of Group II if pending).
- III. Claims 31-35, drawn to the combination of the ligament, bone fasteners, and a motion disc, classified in class 623, subclass 17.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship

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are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because it does not require the ligament to have a width of the conforming portion being smaller than that of the central portion (claims 13-16), a central portion having a thickness of 0.5 mm to less than 2 mm (claims 49-57) or a length 1-3 times the height of the artificial disk (claim 66). The subcombination has separate utility by itself such as being fastened using either sutures or adhesive.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because it does not require the ligament to have a width of the conforming portion being smaller than that of the central portion (claims 13-16), a central portion having a thickness of 0.5 mm to less than 2 mm (claims 49-57) or a length 1-3 times the height of the artificial disk (claim 66). The subcombination has separate utility by itself such as being fastened using either sutures or adhesive.

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The inventions are distinct, each from the other because of the following reasons:

Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because it does not require the ligament to have a conforming portion or shoulderless fasteners, etc. The subcombination has separate utility by itself such as being used without a motion disc.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Furthermore, this application contains claims directed to the following patentably distinct species of the claimed invention. If applicant elects the invention of Group I, the combination of the ligament and fastener, further election of the following patentably distinct species and subspecies is required:

Species I: figure 2a (claims 1, 2, 5-12, 17, 18, 24, 29, 30, 36-48, 58-63, 67-72);

Species II: figure 2c (claims 1-12, 17, 19-23, 25-28, 30, 40-48, 58-63, 67-76);

Species III: figures 3a-3d (claims 1, 2, 5-12, 1, 30, 36-38, 40-48, 58-62, 65);

Species IV: Figures 4a-4c (claims 17, 40-48, 58-62, 73-76);

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Species V: the combination wherein the fasteners have a ceramic attachment end and a polymer shank (claim 64);

Species VI: combination wherein one fastener is shouldered and the other is shoulderless (claim 77).

Each of the above species also includes the following distinct subspecies:

Subspecies A: ligament having a conformable portion;

Subspecies B: ligament having a bioresorbable;

Subspecies C: ligament and fasteners both bioresorbable;

Subspecies D: ligament wherein the central portion has a first resorption time and the end portions have a second longer resorption time.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species and subspecies for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims appear to be generic to all species and subspecies.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations

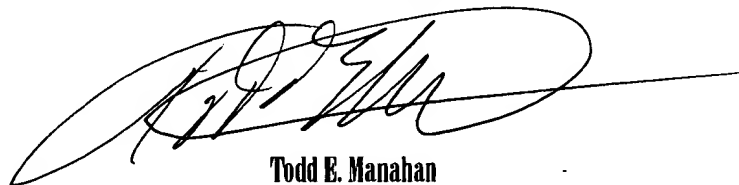
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of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd E. Manahan whose telephone number is (703) 308-2695.

A handwritten signature in black ink, appearing to read 'T. E. Manahan', with a long horizontal line extending to the right.

Todd E. Manahan
Primary Examiner
Art Unit 3732

T. E. Manahan
January 10, 2003